

**REMARKS**

The present amendment is in response to the Office Action dated October 19, 2007, where the Examiner has rejected claims 36-63. In the present amendment, claims 36, 38, 45, 56, 57, 58, 59, 60, 61, 62 and 63 have been amended. Accordingly, claims 36-63 are pending in the present application with claims 36, 38, 45, 56, and 63 being the independent claims. Reconsideration and allowance of pending claims 36-63 in view of the amendments and the following remarks are respectfully requested.

A. Rejection of Claims 36-44 Under 35 U.S.C. 103

Claims 36-43, 44-45, 56 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,198,390 issued to Schlager ("Schlager") in view of US Patent Number 6,091,956 issued to Hollenberg ("Hollenberg"), and further in view of US Patent Application Publication No. 2002/0087401 issued to Leapman ("Leapman").

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

With regard to independent claim 36, the Examiner states that Schlager teaches the limitations of the claims, but does not teach “the user storing a specific activity associated with the at least one target location” and also does not teach “outputting an indication of the specific activity associated with the at least one target location.” The Examiner further states that Hollenberg teaches these limitations. However, Claim 36 has been amended to clarify that the claimed invention operates “without communicating with the target location.” Applicant asserts that the amended claim is not obvious with respect to the references.

1. Suggestion or Motivation to Combine

In the Office Action, there is no identified motivation for combining the references. Schlager and Hollenberg address different problems. The alarm system remote unit in Schlager is designed to address the reliability of a monitoring system. Thus the desire was for the remote unit to transmit at a low power or not at all when no danger exists. (Column 2, lines 45-50). Thus the life of the battery is increased and the system reliability is improved. (Column 2, lines 48-50). On the other hand, Hollenberg is a wireless system for providing services and time critical information. Because of this fundamental difference between Hollenberg and Schlager, their disclosure addresses issues that are unique to them. The Schlager reference addresses the use of a separation distance between a device and a target, which can be used for example to sound an alarm. (See, Schlager, Column 15, Lines 1-16). Schlager also addresses the issue of informing the user of the alarm system when, a baby for example, has crawled outside a safe range. To create the safe range, Schlager utilizes a remote unit and a base station, for example, that are in radio communication with each other and having a separation distance between them. The system activates an alarm when the separation

distance exceeds a limit. (Column 3, lines 10-24). Hollenberg on the other hand, deals with delivering timely information to a wireless communication device and their users proximate to their current locations. (See, Hollenberg, Column 16, Lines 11-24.) Thus in Hollenberg the information delivered is based on the current location. The current location described in Hollenberg is independent of the wireless communication device in the sense that it is not a user defined location. In fact the current location is derived from, for example, advertisers who are interested in displaying an advertisement on a wireless communication device when the device approaches or is within a point of interest.

In addition, Schlager is based on providing information to a user when the personal alarm system remote unit exits a predefined region. Thus the region in Schlager can be defined as a range of acceptable region. When the unit exceeds that acceptable region a low level warning system, for example an alarm, is activated. On the other hand, Hollenberg does not require a predefined range. In fact the device in Hollenberg can receive information regardless of where it is located as long as some interested party, for example an advertiser, has subscribed to provide such information to a wireless communication device upon entering a region. There is no incentive in Hollenberg to notify or activate anything when the wireless communication device exits that region. Thus, at least for the reasons described above, there is no incentive to combine Schlager and Hollenberg.

The Leapman reference describes a filtering mechanism that is compared to incoming advertisements associated with particular locations and displays the advertisement if the filter lets the advertisement through. (See, Leapman, Figure 4). Much like Hollenberg, there is no incentive to combine Leapman with Schlager.

Leapman also addresses the issue of broadcast advertising to wireless communication devices when they approaches or are within a specific location. Because the focus is on advertisers, for example, providing information to a wireless device, the location where the information is received is defined by the advertisers and independent of the user. Thus at least the reasons described herein, there is no incentive or motivation to combine Schlager with Hollenberg and Leapman.

## 2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited the prior art reference points to reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis. For example, Schlager does not teach and the examiner acknowledges on Page 3 of the office action “the user storing a specific activity associated with at least one target location in memory.” (See, Page 3 and 4 of the Office Action.)

Applicant asserts that Hollenberg does not teach this limitation either. However, even if Hollenberg suggests this limitation, one could not reasonably expect to succeed by combining the two references because Hollenberg requires that the advertisement be received via an antenna after the user becomes proximate to the target range. (See, Column 16, Lines 11-24.) Even if Schlager could be combined with Hollenberg, the specific activity that is presently claimed would have to be transmitted to the wireless device after the user entered the target range. This would waste bandwidth, it would increase latency, and it is contrary to the wording of the current claims.

Similarly, it would be impossible to put all of the possible advertisements into the memory of a wireless device in advance of entering the target range because there are

too many advertisements, they change too often, and the wireless device has limited resources. In fact, the present application specifically avoids the drawbacks that would occur if the specific activity were not put into memory beforehand. These are the very same drawbacks that would hinder the expectation of success of the proposed combination, if it were possible to combine Schlager with Hollenberg.

Moreover, a filter as in Leapman does not make the expectation of success any more likely. By its nature, the filter operates on data that is downloaded or “broadcast” as the user enters the target area. (See, Leapman, Paragraph 32) For that reason, any specific activity cannot be pre-programmed because it is uncertain if it will even be displayed on the screen. The device in Leapman would need to have every potential advertisement pre-programmed into memory before using the device for such specific activity to be pre-stored before entering the target area.

Such a pre-programming is not possible on the limited memory of a portable device. As such, the addition of Leapman does not make the proposed combination succeed since it cannot be anticipated what advertisements will be broadcast before entering the target area. Similarly, the “acceptance data” used as a filter, even though it is pre-programmed does not operate as an indication of a specific activity because acceptance data is never displayed to the user. The acceptance data merely filters out unneeded advertisements that are broadcast to the device. Therefore, the proposed combination does not have a reasonable expectation of succeeding in performing the present claims.

### 3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. The examiner

acknowledges that Schlager does not specifically teach “the user storing a specific activity associated with at least one target location in the memory” and “outputting an indication of the specific activity associated with at least one target.” However, the examiner states that it will be obvious to combine the limitations of Hollenberg and Schlager to meet all of the limitations of claim 36. With regards to these limitations, claim 36 has been amended to read “outputting the content related to the specific activity associated with the at least one target location on a user interface of the wireless communications device if the present location is within the target area without communicating with the target location.” Applicant asserts that Schlager fails to teach the limitations of the amended claim and the addition of Hollenberg and Leapman fails to cure the basic deficiencies.

Schlager, teaches that an alarm, for example, is sounded or not depending on whether the remote unit is within or outside an acceptable region. (Column 3, lines 23-25) Such a sounding of an alarm is not a “specific activity” as acknowledged in page 3 of the office action. It is merely an alarm that is not specific, not changeable, and not defined by the user. Furthermore, Schlager is exactly opposite the claims because the trigger in Schlager is when the device moves away from a target not when a device moves into a target region. (column 3, lines 17-18)

Hollenberg fails to cure the basic deficiencies of Schlager. In Hollenberg, displaying an advertisement when a user enters a certain area or enters a store fails to satisfy the limitations of the amended claim. First, Hollenberg fails to teach that the text message displayed by the wireless device meets the limitation of “the user storing a specific activity associated with the at least one target location in the memory before entering the target range.” Hollenberg merely receives information via an antenna and

conveys the information (such as an advertising message) to a user display. (See, Column 16, Lines 11-24). The purpose of the antenna in Hollenberg is to receive input data when the user enters the target range. Thus the information received cannot meet the limitation of claim 36; instead it is advertiser defined information.

Even if it was interpreted that the information displayed in Hollenberg was somehow stored by the user Hollenberg still fails to describe the limitations of claim 36. For example claim 36 as amended describes “outputting the content related to the specific activity associated with the at least one target location on a user interface of the wireless communications device if the present location is within the target area without communicating with the target location.” Hollenberg at least communicates with the target location prior displaying information on a display of the wireless device. Since Hollenberg does not store the advertisement in the wireless device “before the user becomes proximate to the target range” the advertisement is downloaded to the device and not pre-stored. For such a download to occur the device has to establish a communication link with the target location prior to displaying anything on the wireless device. This communication link is contrary to the limitations of claim 36.

In addition, Leapman fails to cure the basic deficiencies of Schlager and Hollenberg. Leapman merely adds a filtering mechanism to the combination of the prior two references.

The examiner states that the claimed feature of indication actually reads on the scenario of the grocery store broadcasting an item on sale such as skim milk. Applicant asserts that Leapman fails to disclose the amended claim limitations. For example amended claim 36 describes “outputting the content related to the specific activity associated with the at least one target location on a user interface of the wireless

communications device if the present location is within the target area without communicating with the target location. Leapman forms a communication link between the target location and the wireless device by broadcasting an item on sale from the target location to the wireless device. (Abstract) Forming such a communication link prior to displaying the broadcast information on the wireless device is contrary to the limitations of claim 36.

Further, Leapman stores only acceptance criteria in memory, but the acceptance criteria is merely a filter for content received from a remote location. The acceptance criteria is not pre-stored content because it is never displayed to the user when the device is proximate to a target area. Since the acceptance criteria is never shown to the user and merely filters advertisements (the advertisements being broadcast only when the user enters the target area), Leapman does not include the present limitation that is pre-programmed into memory prior to entering the target area.

Since the combination of references does not include all the limitations of claims 36-45, 56 and 63, the Applicant requests that the rejection be withdrawn.

#### 4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit's teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been identified and



therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the prior art of record.

B. Rejection of Claims 45-49 and 53-62 Under 35 U.S.C. 102

Claims 45-49 and 53-62 are rejected as anticipated under 35 U.S.C. 102(b) based on Schlager. Applicant has amended independent claims 45 and 56. Applicant asserts that Schlager does not teach, suggest, or describe a “target message for the each target location comprising a specific activity associated with the each target location being entered into the memory.”

Schlager, teaches that an alarm, for example, is sounded or not depending on whether the remote unit is within or outside an acceptable region. (Column 3, lines 23-25) Such a sounding of an alarm is not a “specific activity” It is merely an alarm that is not specific, not changeable, and not defined by the user. Furthermore, Schlager is exactly opposite the claims because the trigger in Schlager is when the device moves away from a target not when a device moves into a target region. (column 3, lines 17-18). Thus, a warning as taught by Schlager does not prompt the user to perform a specific activity as claimed by Applicant nor is it input before the user enters the target area. Therefore, Schlager clearly does not disclose the claims.

As such, Applicant asserts that Schlager does not anticipate the independent claims 45 and 56. Additionally, Applicant respectfully asserts that Schlager does not disclose each and every element of the dependent claims 46-49, 53-55, and 57-62. Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for the pending independent claims 45 and 56 and their respective dependent claims 46-49, 53-55, and 57-62.

C. Rejection of Claims 50-52 Under 35 U.S.C. 103

In the Office Action, claims 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlager. With regard to claim 50, the Examiner states that Schlager teaches the limitations of claims 50, but does not teach that the wireless communications device is a laptop, a pager, or a PDA. The Examiner further states that such limitations are obvious based on Schlager. With regard to claim 52, the Examiner states that Schlager teaches the limitations of claims 52, but does not teach that target range area is two-dimensional or three-dimensional space. The Examiner further states that such limitations are obvious based on Schlager.

The arguments presented with respect to the obviousness rejection of independent claims 36 and 38 also apply to independent claim 45, upon which the currently rejected claims 50 and 52 depend. The subject matter of presently claimed in claim 45 is for location-based responses to a user utilizing a wireless communications device, in which the user stores a specific activity associated with the at least one target location in the memory before the user enters or becomes proximate to the range area associated with the target location.

The Schlager reference addresses the use of a separation distance between a device and a target, which can be used for example to sound an alarm. (See, Column 15, Lines 1-16). Schlager fails to create a suggestion or a motivation for a user to store a specific activity associated with the at least one target location in a memory, "before the wireless device is proximate to the range area," which is included in the independent claims 45.

Moreover, the Examiner has not demonstrated that the modification of the cited reference points to the reasonable expectation of success in the present claims, which

is the second requirement of the obviousness analysis. For example, Schlager does not teach a specific activity associated with a target range, and the Examiner does not demonstrate that Schlager could be successfully modified to perform that limitation with respect to claim 45. As such, there is also no reasonable expectation of success to perform the limitation on a laptop, PDA, or pager as in claim 50 or in 2-D or 3-D space as in claim 52.

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. For example, the present claim 45 provides that the user stores a "specific activity" associated with the at least one target location in the memory before approaching a range area. Schlager discloses self-locating remote monitoring systems in which a base station receives information from the remote device to determine appropriate actions, such as sounding alarms (See, Column 7, Lines 5-10.)

In Schlager, the teaching is to sound an alarm or not sound an alarm. Such a sounding or not sounding of an alarm is not a "specific activity." It is merely an alarm that is not specific, not changeable, and not set by the user. As such, performing the above limitation on a laptop, PDA, or pager as in claim 50 or in 2-D or 3-D space as in claim 52 is also not taught by Schlager. Since the combination of references does not include all the limitations of claims 50-52, the Applicant requests that the rejection be withdrawn.

D. Conclusion

For all the foregoing reasons, an early allowance of claims 36-63 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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/George W. Luckhardt/  
George W. Luckhardt  
Reg. No. 50,519

George W. Luckhardt  
KYOCERA WIRELESS CORP.  
Attn: Patent Department  
P.O. Box 928289  
San Diego, California 92192-8289  
Tel: (858) 882-2593  
Fax: (858) 882-2485